

Rejections Under 35 U.S.C. § 103(a)

2. Claims 7-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Katsumi (7-308936) in view of Nishio et al. (US 6,103,999). Applicant respectfully traverse the rejection.

“The prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is reasonable expectation of success.” MPEP § 2143.02 (citing *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)). The Examiner states:

Katsumi fails to disclose that the printed part formed on the first binder layer and a second binder layer formed so as to seal the printed part in co-operation of the first binder part.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have the printed part formed on the first binder layer and a second layer formed so as to seal the printed part in co-operation with the first binder layer, since it has been held that rearranging parts of an invention involves only routine skill in the art absence of showing unexpected results. *In re Japikse*, 86 USPQ 70.

See Office Action at p. 3. Applicants respectfully disagree and submit that the elements of invention taught by Katsumi cannot be successfully rearranged.

The first binder layer 13 and second binder layer 14 as disclosed by Katsumi are actually the solidified skin layers of the molten polycarbonate resin 7. See Katsumi Abstract, line 17-19. These skin layers are not discrete components of the pattern encapsulated molded product disclosed by Katsumi but are rather outer surfaces of the PC resin as the PC resin hardens. Therefore, these skin layers cannot be removed from the resin and reapplied to seal the pattern forming surface 9 as the Examiner suggests. Claim 7 as amended, on the other hand, recites a printed part that is sealed by two discrete binder layers. Therefore, Katsumi cannot be expected

to have to success of the invention as recited by claim 7 because Katsumi's molded product cannot successfully seal the printed part with two discrete binder layers. Nishio is silent as to having a printed part sealed with two binder layers.

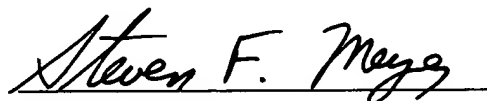
Katsumi cannot be expected to have the success of the invention as recited in claim 7 for another reason. The invention recited in claim 7 is used to prevent ink flow in the printed part, whereas Katsumi is directed to improve adhesion between a pattern forming surface and a molding material. The pattern encapsulated molded product disclosed by Katsumi cannot be expected to prevent ink flow in the printed part because it was made strictly for the purpose of improving adhesion. Nishio is also not directed to prevent ink flow in the printed part.

For these reasons, Applicants submit that claim 7 is not obvious in light of Katsumi in view of Nishio, and claim 7 is allowable over the cited references. Moreover, because claims 8-14 depend directly or indirectly from claim 7, they also recite this limitation. Applicants therefore submit that claims 8-14 are likewise allowable. In light of the above amendments and arguments, Applicants respectfully request that this rejection be withdrawn.

CONCLUSION

For these reasons, it is believed that all of the claims as presently amended, are patentable, and that this application is in allowable condition.

Respectfully submitted,


Steven F. Meyer
Registration No. 35,613

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CORRESPONDENCE ADDRESS:

MORGAN & FINNEGAN, L.L.P.

345 Park Avenue

New York, New York 10154

(212) 758-4800

(212) 751-6849 Telecopier

APPENDIX 1

(Version With Markings To Show Changes Made In The Specification)

IN THE CLAIMS:

Please AMEND claim 7 as follows:

7. (Amended) A resin panel comprising:

[the insert film of claim 1; and]

a resin panel body; and

an insert film arranged on a surface of said resin panel body, said insert film comprising:

a resin film;

a first binder layer formed on the surface of the resin film;

a printed part formed on the first binder layer; and

a second binder layer formed so as to seal said printed part in co-operation with the first binder layer, wherein said [a] resin panel body is integrally molded with [the] said insert film by an insert molding [in a state such] so that a surface of the resin film of [the] said insert film at the side on which a printed part is formed faces inside.

Please ADD new claims 13 and 14, which reads as follows:

--13. (New) The resin panel according to claim 7, wherein the periphery of the second layer is printed to overlap the periphery of the first layer.--

--14. (New) The resin panel according to claim 7, wherein the printed part is coated along the periphery of the insert film.--